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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86087067
Applicant	Paul David Marotta
Applied for Mark	THE CORPORATE LAW GROUP
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IN THE TRADEMARK TRIAL AND APPEALS BOARD

APPEAL BRIEF RE: THE CORPORATE LAW GROUP

In re Application:	Appeal No. 86087067
Serial No.: 86087067	Examining Atty: Jonathon R. Falk
Mark: THE CORPORATE LAW GROUP	**Applicant's Reply Brief**
Applicant: Paul David Marotta	
Class No.: 42	

As far as Applicant can tell this is a matter of first impression. Applicant has been using his mark THE CORPORATE LAW GROUP (the "Mark") as a source identifier for almost 25 years. In all that time Applicant has not been aware of anyone using anything similar to the Mark as a source identifier other than, possibly, Walker Corporate Law Group, PLLC ("Walker")[1]. And when Applicant first became aware of Walker he took tremendous interest in that use and looked for confusion. To this date he has never seen any confusion between the Mark and the name being used by Walker. Additionally Applicant's Mark has been twice registered on the Patent and Trademark Office's Principal Register and declared incontestable. Finally, Applicant has

[1] Examiner found one other name, Galler Corporate Law, of which Applicant had been unaware. But this one use, not identical, and without confusion, is hardly evidence of anything

submitted declarations from over 20 clients and from 9 lawyers all of whom identify the Mark solely and exclusively with the Applicant.

This matter comes to the Trademark Trial and Appeals Board ("TTAB") not on an opposition, by way of litigation, or in connection with any sort of challenge. It comes here because, despite the above facts, the Examining Attorney ("Examiner") has refused registration. Applicant submits that there is no way to satisfy the Examiner. It would not have mattered how many lawyer testimonials Applicant submitted. It made no difference that Applicant provided declarations from several lawyers. That Applicant had used his mark exclusively for almost 25 years did not matter.

Similarly even though one profession sometimes uses a similar phrase although not as a source identifier made no difference. Applicant submits that this is wrong and that the Patent and Trademark Office should allow Registration of his Mark. After all our society has only one recognized repository for intellectual property ownership claims and this is what is available to Applicant.

I. REPLY

1. The Examining Attorney's Evidence is an Insufficient Record for Refusal.

Examiner refers to 24 examples of third parties using Applicant's Mark. But none of these are public uses of the phrase "The Corporate Law Group," as a source identifier.

Most are an internal shorthand sometimes used by a large law firm to refer to its group of corporate lawyers versus its group of litigators or group of real estate lawyers. It might be a term not uncommon to lawyers but it is certainly not a term in any way common to anyone outside the legal profession.

As explained in Applicant's opening Brief, the relevant public for a genericness determination is "the purchasing or consuming public for the identified services." *Coach/Braunsdorf, Inc. v. 12 Interactive, LLC*, Cancellation No. 92051006, at pg. 9 (TTAB March 24, 2014); citing *Magic Wand, Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

The consuming public for Applicant's legal services is not made up of large law firm

partners or lawyers. The consuming public is entrepreneurs such as the over 20 clients for whom Applicant submitted declarations. Yet the majority of the 24 examples submitted by Examiner are uses in such things as press releases written by large law firms. They are using their own internal shorthand, not using a brand identifier. Therefore, the Mark is not generic. Just because a specialized profession might use a phrase doesn't mean that everyone does. The use to which most of Examiner's evidence relates is not to any use by the general public but to use by law firms talking about themselves.

2. It is Not Irrelevant that Applicant's Mark was Twice Registered and Declared Incontestable.

Examining Attorney essentially argues that the two prior registrations and the declaration of incontestability are meaningless. In support this, the EA cites *In Re Nett Designs, Inc.*, 236 F.3rd 1339 (2001) and *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2nd 1403 (1973).

The question in *In Re Nett Designs* was whether allowance of the word "Ultimate" in third party registrations somehow invalidated the examiner's disclaimer requirement of "Ultimate" in the mark in question. The court said at 1342:

> "Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application."

This matter is much different from *In Re Nett Designs* was. Here, the 'prior registration' being examined is the identical Applicant for the identical Mark. If the PTO argues that two prior registrations and a declaration of incontestability are irrelevant in a case where a trademark owner is simply attempting to re-register his mark, where nothing in the market has changed, and where secondary meaning has strengthened, that is wrong and it is unfair.

Similarly *AMF* involved the TTAB dismissing an opposition to the application for registration by American Leisure Products of a fish design to be used with sailboats. In overturning the TTAB's opposition dismissal, the court said that:

> "It appears that the board relied heavily upon the existence of third-party trademark registrations in reaching its decision. We have frequently said that little weight is to be given such registrations in evaluating whether there is likelihood of confusion.

> The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." [citing *In re Helene Curtis Industries, Inc.*, 305 F.2d 492 (1962); other citations omitted].

Again, the case has nothing to do with a prior registration being cited by that registrations owner in trying to achieve registration again of a mark accidentally canceled. This matter does not involve a claim of infringement, testing an opposition, or a disclaimer requirement. In fact, Applicant submits that the only real question in this matter is if Applicant has abandoned his Mark or allowed his Mark to be diluted. In other words, what is the status of Applicant's use of his Mark in the marketplace.

Anderson, Clayton and Co. v. Kreir, 478 F.2nd 1246 (1973), also cited by Examiner, involved an appeal following dismissal of an opposition. There, applicants mark was 7 SEAS (which had previously been registered but which registration had been canceled), and appellant's mark was SEVEN SEAS. Appellants mark(s) was registered before Applicant's application, but Applicant was arguing that it had prior use. The TTAB looked into priority of use, but the court overturned the dismissal the court saying that:

> "Under section 2(d), priority determines the right to register in an opposition proceeding only in those cases where the opposer has no registered trademark. There are no other exceptions in the statute, and we see no justification for engrafting one upon it. Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled."

In other words the court said that priority did not matter where an opposer had a registered mark. Here there is no registered mark in opposition and *Anderson v. Kreir* offers no instruction. Applicant is not looking for any statutory benefit or legal presumption. Applicant merely argues that, since nothing has changed since the prior registrations, and those registrations were proper, the current registration should not be refused.

Applicant's prior registrations were proper. There is no one else using Applicant's Mark. Applicant has not stopped using his Mark. Applicant has not been dilatory while others have infringed. Applicant has not dedicated his Mark to the public domain. In fact, Applicant has viewed with pride many other lawyers branding their law firm "The 'XYZ' Law Group."

Here, 15 years after first applying for registration, this Applicant's use is still exclusive, there is no confusion, and the relevant public, people like Applicant's clients, associate the Mark only and exclusively with the Applicant. There is no authority for refusing a re-registration where the only act being examined is a new registration.

II. CONCLUSION

Examiner argues that two important reasons for not allowing registration of a generic or descriptive mark are to (i) prevent the owner from inhibiting competition, and (ii) prevent costly infringement litigation.[2] Here, Applicant has been using his Mark for almost 25 years, his Mark was registered twice and declared incontestable, and Applicant's Mark was registered for over 10 years, but Applicant has yet to bring litigation related to the Mark.

Because Examiner's 24 evidence samples mostly consist of law firms referring to themselves, hardly a use by the consuming public, this Registration should be allowed.

And because Applicant's two prior registrations are not being examined in the light of an opposition, and nothing in the market has changed, this Registration should be allowed. The fact that Applicant's Mark was previously found not to be generic, found to have achieved secondary meaning and acquired distinctiveness, and declared incontestable, is not wholly without probative value in asking whether re-registration is appropriate. Anything other than giving some not inconsequential weight to these facts would be unfair.

Additionally, Applicant's Mark is not merely descriptive because (a) it has been in open and exclusive use for almost 25 years, (b) it has been the subject of significant advertising and promotion, (c) over 20 business persons have identified it with Applicant, (d) nine lawyers have identified it with Applicant, (e) it has been used with clients from many different states and countries, (f) the public understands THE CORPORATE LAW GROUP to primarily refer to the law firm started by Paul David Marotta in 1991, (g) persons seeking divorce, criminal defense, estate planning, or real estate legal services would not seek them from THE CORPORATE LAW

[2] Examining Attorney's Appeal Brief, page 8.

GROUP, and (h) even if some people might understand that corporate governance and entity formation are included in the broader 'corporate law' that doesn't make 'corporate law' synonymous with all 'legal services.'

For all of these reasons Applicant should be allowed to register on the principal register his Mark, THE CORPORATE LAW GROUP.

DATED this 4th day of May, 2016. **The Corporate Law Group**

/s/ Megan Jeanne
Megan Jeanne for Applicant